

therefore, responds below as if the rejection were based on all four of these United States patents.

**Aronberg**

Aronberg discloses a system and method for software distribution and desktop management in a computer network environment.

**Dunn**

Dunn discloses the gathering of data handling statistics in non-synchronous data communication networks. Dunn indicates that a timing script could be provided in a preselected script language and transmitted along with an "applet" (mini-application) that: self installs at the client station; then executes automatically without dependence upon any program resident at that station; and ultimately is discarded after the associated data is discarded by the client station. See column 8, lines 42 through 48.

**Touboul**

Touboul discloses a method and apparatus for monitoring and controlling in a network. The objects of the invention disclosed within Touboul include providing a network maintenance system which can identify failures of programs running on network workstations and take the appropriate corrective action to correct the problems that led to those failures and include providing a

system which can correct problems on workstations within the S network by sending procedures to agents active on the workstations, each procedure consisting of one or more actions to be taken. See column 1, line 61 through column 2, line 3.

### Hodges

Hodges discloses a method and system for providing automated updating and upgrading of antivirus applications using a computer network.

### Criteria for Rejection under 35 U.S.C. § 103(a)

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings as suggested by the Examiner.

### **Discussion of Independent Claim 1**

Claim 1 sets out a method by which a managing computer manages applications residing on a managed computer. In step (a), an agent from the managing computer is forwarded to the managed computer. The agent, upon arriving at the managed computer, installs itself on the managed computer and maintains specified applications residing on the managed computer. The maintenance includes making updates to the specified applications when new versions of the specified applications are available on the managing computer.

Examiner has argued that various parts of claim 1 are disclosed in three references.

Examiner asserts Touboul discloses a managing computer managing applications residing on a managed computer, but does not teach an agent, upon arriving at the managed computer, installing itself on the managed computer and maintaining specified applications residing on the managed computer. Touboul also does not teach that maintenance includes making updates to the specified applications when new versions of the specified applications are available on the managing computer.

Examiner asserts that Hodges discloses maintaining software and making updates as necessary. Examiner however indicates that neither Touboul nor Hodges discloses forwarding an agent from a managing computer to a managed

computer, and neither reference discloses the agent installing itself on the managed computer.

Examiner asserts that Dunn discloses the ability of code to self install.

#### Piecemeal Reconstruction of Claims Does Not Show Obviousness

In essence, Examiner has attempted to, in a piecemeal fashion, reconstruct the limitations of claim 1. That is, Examiner has asserted Touboul discloses a managing computer managing applications residing on a managed computer, Hodges discloses maintaining software and making updates as necessary, Dunn discloses the ability of code to self install. Using claim 1 as a framework, a person of skill in the art could combine these selected teachings from these references into something similar to the subject matter set out in claim 1.

However, piecemeal reconstruction of prior art patents in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103. *In re Kamm and Young*, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972). It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q. 2d 1434 (Fed. Cir. 1988).

In order to show obviousness, Examiner must provide sufficient a suggestion in the prior art (not in Applicant's Specification) for any suggested combination. Specifically, for a rejection under 35 U.S.C. § 103, the prior art must provide a motivation or reason for the worker in the art, without the

benefit of the appellant's specification, to make the necessary changes in the reference device. See *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. See *In re Newell*, 891 F.2d 899, 12 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989). Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988).

#### Not Obvious to Combine Touboul and Dunn

Examiner stated rationale for combination of the Touboul and Dunn does not show obviousness. Specifically, Examiner has argued that it would be obvious to implement Touboul's agent software with "self installation" and being sent from the managing computer as found in Dunn's teaching as a person of ordinary skill in the art would be motivated to make use of software which is self-contained and self reliant.

However, this would not be an obvious modification to Touboul's agent software as it would have the effect of destroying the invention upon which Touboul is based.

The courts have indicated that a modification of a reference which results in destroying that on which the invention of the reference is based should not

serve as a foundation for a rejection under 35 U.S.C. § 103. See, for example, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (PTO Bd. App. 1974).

Touboul specifically states that it is an object of his invention to provide a system which allows automatic discovery of agents. See, for example, column 2, lines 16, 17. Automatic discovery of agents is also an element of claims 2, 3, 5, 6, 9 and 10.

Modifying Touboul as suggested by Examiner, to implement Touboul's agent software with "self installation" and being sent from the managing computer as found in Dunn's teaching would effectively destroy the basis for automatic discovery of agents in Touboul. Thus, modifying Touboul as suggested by Examiner would have the effect of destroying the invention upon which Touboul is based. This is not an obvious modification of Touboul.

#### **Independent Claim 11**

Independent claim 11 sets out an agent running on a managed computer managed by a managing computer. The agent includes an integrity sensor, an action sensor and a main engine. This is not disclosed or suggested by the cited prior art.

Examiner has argued that the limitations of claims 11 through 16 and 21 are the same as in claims 1 through 10, only arranged differently. However, this is clearly not the case.

Specifically, claims 1 through 10 do not specifically state or suggest that an agent comprises an integrity sensor, an action sensor and a main engine as set out in claims 11.

Likewise, the elements of claim 11 are not disclosed or suggested by the cited prior art.

For example, claim 11 indicates an integrity sensor monitors integrity of specified applications within the managed computer to ascertain when repair is needed. This functionality is not disclosed or suggested by the cited Prior art. Touboul, for example, discusses an administrator attaching one or more triggers to cause an action to be taken. See column 8, lines 43 through 52. However, nothing in Touboul discloses or suggests that an agent includes an integrity sensor that monitors integrity of a specified applications within the managed computer to ascertain when repair is needed.

Likewise, the agent set out claim 11, in addition to an integrity sensor, includes an action sensor that monitors communications from the managing computer to determine when the managing computer desires the agent to take a requested action, and includes a main engine that maintains the specified applications, wherein maintaining the specified applications includes making updates to the specified applications when new versions of the specified applications are available on the managing computer. There is no disclosure or suggestion in the prior art that the functionality of an integrity sensor, an action

sensor and a main engine all are implemented within a single agent running on a managed computer.

### **Independent Claim 17**

Independent claim 17 sets out storage media that stores programming code which when run implements an agent running on a managed computer managed by a managing computer. The agent includes an integrity sensor, an action sensor and a main engine. This is not disclosed or suggested by the cited prior art.

Examiner has rejected claims 17 under the same rationale as claim 11, however, as discussed above, the elements of claim 17 are not disclosed or suggested by the cited prior art.

For example, claim 17 indicates an integrity sensor monitors integrity of specified applications within the managed computer to ascertain when repair is needed. This functionality is not disclosed or suggested by the cited Prior art. Touboul, for example, discusses an administrator attaching one or more triggers to cause an action to be taken. See column 8, lines 43 through 52. However, nothing in Touboul discloses or suggests that an agent includes an integrity sensor that monitors integrity of specified applications within the managed computer to ascertain when repair is needed.

Likewise, the agent set out claim 17, in addition to an integrity sensor, includes an action sensor that monitors communications from the managing




computer to determine when the managing computer desires the agent to take a requested action, and includes a main engine that maintains the specified applications, wherein maintaining the specified applications includes making updates to the specified applications when new versions of the specified applications are available on the managing computer. There is no disclosure or suggestion in the prior art that the functionality of an integrity sensor, an action sensor and a main engine all are implemented within a single agent running on a managed computer.

#### Conclusion

Applicant believes that the present case is in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,  
HUEY LY

By   
Douglas L. Weller  
Reg. No. 30,506

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Santa Clara, California  
(408) 985-0642